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| 09/539,269      | 03/30/2000  | Stephen R. Hanna     | SUN-p4324-RSH       | 8981             |

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PARK, VAUGHAN & FLEMING LLP  
508 SECOND STREET  
SUITE 201  
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EXAMINER

ENGLAND, DAVID E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2143

DATE MAILED: 07/14/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/539,269

Applicant(s)

HANNA ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1 – 30 are presented for examination.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the delivering an encrypted version of the attachment, receiving a receipt for the encrypted version of the attachment, and sending the decryption key for the attachment must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any

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required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 11 and 21 are ambiguous as to what or where decryption or encryption is happening in the system; and who or what is receiving or sending the encrypted attachment, receipt and decryption key.

5. Referencing claims 1, 11 and 21, it is unclear in the claims as to the true meaning/definition of "receipt". Furthermore, there is no support in the specification that gives the limitation of "receipt" a specific definition.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 9, 10, 11, 12, 19, 20, 21, 22, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6275848) in view of what is well known in the art in further view of Beck et al. (5903723) (hereinafter Beck).

8. Referencing claim 1, Arnold teaches a method for replacing an attachment to an email message with a reference to a location of the attachment, comprising:

9. receiving the email message, (e.g. col. 1, lines 13 – 25);

10. examining the email message to determine if the email message includes an attachment, (e.g. col. 2, lines 20 – 60); and

11. if the email message includes the attachment,

12. storing the attachment at a location on a communication network from which the attachment can be retrieved, (e.g. col. 2, lines 20 – 50),

13. modifying the email message by replacing the attachment with a reference specifying the location of the attachment on the communication network, (e.g. col. 2, lines 20 – 50),

14. sending the modified email message to a recipient of the email message, (e.g. col. 2, lines 20 – 50),

15. providing proof of receipt of the contents of the attachment, (e.g. col. 4, line 25 – col. 5, line 6, “*preferably only the originator of the message and the intended recipients have access to the access list, and preferably the only operation recipients may do is delete themselves from the list.*”), and

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16. deleting the attachment from the location on the communication network after on of:

17. receiving a notification that all recipients of the email message have retrieved the attachment, (e.g. col. 4, line 25 – col. 5, line 56), but does not specifically teach receiving a notification that all recipients of the email message have deleted the email message;

wherein providing proof of receipt involves:

18. delivering an encrypted version of the attachment,

19. receiving a receipt for the encrypted version of the attachment, and

20. sending the decryption key for the attachment

21. Official Notice is taken that it was a common practice to receiving a notification that all recipients of the email message have deleted the email message at the time the instant invention was made.

22. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Arnold to receiving a notification that all recipients of the email message have deleted the email message using the teaching of common practice. The modification would be obvious because one of ordinary skill in the art would be motivated to receiving a notification that all recipients of the email message have deleted the email message because in conventional e-mail systems when an e-mail with an attachment is deleted the attachment attached to the e-mail is deleted with the e-mail. If a user or a group of users desire to delete an e-mail, then it would be obvious that the user or group of users no longer need the e-mail or its contents taking up space in their “mailbox”, therefore, deleting anything attached or associated with the email.

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23. Beck teaches wherein providing proof of receipt involves:

24. delivering an encrypted version of the attachment, (e.g. col. 6, lines 13 – 67, “... *attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP server.*” & col. 7, lines 19 – 40, “...*other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes*”),

25. receiving a receipt for the encrypted version of the attachment, (e.g. col. 6, lines 13 – 67, “... *attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP server.*” & col. 7, lines 19 – 40, “...*other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes*”), and

26. sending the decryption key for the attachment, (e.g. col. 6, lines 13 – 67, “... *attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP server.*” & col. 7, lines 19 – 40, “...*other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes*”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Beck with Arnold and what is well known

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in the art because providing a type of encryption to an email and/or an attachment to an email will ensure that unauthorized users browsing the WWW HTTP servers are unable to obtain a usable copy of the attachment file.

27. Referencing claim 2, Arnold teaches receiving the modified email message at the recipient, (e.g. col. 2, lines 20 – 50); and

28. using the reference specifying the location of the attachment to retrieve the attachment across the communication network, (e.g. col. 2, lines 20 – 50).

29. Referencing claim 9, Arnold teaches wherein the attachment is a file, (e.g. col. 2, lines 20 – 50).

30. Referencing claim 10, Arnold teaches the reference specifying the location of the attachment includes a uniform resource locator (URL), (e.g. col. 3, line 57 – col. 4, line 5).

31. Claims 11, 12, 19, 20, 21, 22, 29 and 30 are rejected for similar reasons as stated above.

32. Claims 3 – 5, 8, 13 – 15, 18, 23 – 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6275848) in view of what is well known in the art in

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further view of Beck (5903723) in further view of Eldridge et al. (6397261) (hereinafter Eldridge).

33. As per claim 3, Arnold and Beck do not specifically teach retrieving the attachment includes authenticating the recipient to a computer system upon which the attachment is stored. Eldridge teaches retrieving the attachment includes authenticating the recipient to a computer system upon which the attachment is stored, (e.g. col. 5, line 47 – col. 6, line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art and Beck because it would be more secure if the user utilized an authentication system in the invention so to keep unauthorized users from accessing attachments that are private in nature.

34. As per claim 4, Arnold and Beck do not specifically teach receiving the email message includes receiving the email message at one of,

35. an application residing on a computer system belonging to a sender of the email message;

36. an email server through which the email message is sent;

37. a firewall that protects at least one trusted computer system from communications across the communication network; and

38. a gateway that converts the email message from a first format to a second format.

Eldridge teaches receiving the email message includes receiving the email message at one of,

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39. an application residing on a computer system belonging to a sender of the email message, (e.g. col. 5, line 47 – col. 6, line 64);

40. an email server through which the email message is sent, (e.g. col. 5, line 47 – col. 6, line 64);

41. a firewall that protects at least one trusted computer system from communications across the communication network, (e.g. col. 5, line 47 – col. 6, line 64); and

42. a gateway that converts the email message from a first format to a second format, (e.g. col. 5, line 47 – col. 6, line 64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art and Beck because the system would be more secure if the email were to go through some type of security point to prevent unauthorized email to enter different domains or systems so not to corrupt or damage any system from working, also, if needed, a second format would be needed if different protocols were implemented in the system that the email is being sent to making the system more versatile in accepting different types of network transport formats.

Furthermore, having the system with an email server with a user having an application residing on a computer system belonging to a sender of the email message would be more convenient because it is a common practice in email technology.

43. As per claim 5, Arnold and Beck do not specifically teach allowing the attachment to be updated at the location on the communication network. Eldridge teaches allowing the attachment to be updated at the location on the communication network, (e.g. col. 17, lines 8 – 16). It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art and Beck because if the attachment is old and newer versions of the attachment were available, it would be more efficient for a system to have an updated version of the attachment incase of important information that was added can be viewed and not missed.

44. As per claim 8, Arnold and Beck do not specifically teach if the email message includes the attachment, the method further comprises:

45. asking a sender of the email message whether to replace the attachment with the reference specifying the location of the attachment; and

46. replacing the attachment only if the sender agrees to replace the attachment.

Eldridge teaches if the email message includes the attachment, the method further comprises:

47. asking a sender of the email message whether to replace the attachment with the reference specifying the location of the attachment, (e.g. col. 7, lines 15 – 58); and

48. replacing the attachment only if the sender agrees to replace the attachment, (e.g. col. 7, lines 15 – 58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art and Beck because it would be more convenient for a user to have the option to replace the attachment if there is one present and/or the attachment is not a too big, causing a potential error in transmission.

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49. Claims 8, 13 – 15, 18, 23 – 25, and 28 are rejected for similar reasons as stated above.

50. Claims 6, 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6275848) in view of what is well known in the art in further view of Beck (5903723) in further view of Pollack (6505236) in further view of Trenbeath et al. (6324587) (hereinafter Trenbeath) in further view of Birrell et al. (6092101) (hereinafter Birrell).

51. As per claim 6, Arnold and Beck do teach the deletion of attachments, (e.g. col. 2, line 20 – 50), but does not specifically teach deleting the attachment from the location on the communication network after at least one of:

52. an expiration of a time period;

53. sending a notification to recipients of the email message that the attachment is to be deleted;

54. receiving a command to delete the attachment from a sender of the email message; and

55. storing the attachment to archival storage. Pollack teaches deleting the attachment from the location on the communication network after at least one of:

56. an expiration of a time period, (e.g. col. 2, lines 26 – 57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pollack with the combine system of Arnold, what is well known in the art and Beck because it would be more efficient if the system had a way to delete information that is

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old and no longer being used by the user. Pollack does not specifically teach sending a notification to recipients of the email message that the attachment is to be deleted;

57. receiving a command to delete the attachment from a sender of the email message; and

58. storing the attachment to archival storage. Trenbeath teaches sending a notification to recipients of the email message that the attachment is to be deleted, (e.g. col. 9, lines 19 – 35);

59. receiving a command to delete the attachment from a sender of the email message, (e.g. col. 29, line 60 – col. 30, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Trenbeath with the combine system of Arnold, what is well known in the art, Beck and Pollack because of similar reasons as stated above. Trenbeath does not teach storing the attachment to archival storage. Birrell teaches storing the attachment to archival storage, (e.g. col. 1, lines 51 – 59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Birrell with the combine system of Arnold, what is well known in the art, Beck, Pollack and Trenbeath because if a user needed the information that was old for historic reference then it would be more efficient if the user had an option of storing the attachment in a different location, (i.e. personal folder), so to free up space for other user's attachments that are not old.

60. Claims 16 and 26 are rejected for similar reasons as stated above.

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61. Claims 7, 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6275848) in view of what is well known in the art in further view of Beck (5903723) in further view of Birrell (6092101).

62. As per claim 7, Arnold teaches the communication network includes at least one of:

63. a computer network, (e.g. col. 3, lines 51 – 56), but does not specifically teach a telephone network. Birrell teaches a telephone network, (e.g. col. 4, lines 26 – 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Birrell with the combine system of Arnold, what is well known in the art and Beck because it would be more versatile for a user to utilize the system on a two potentially different types of networks, LANs and dial-up networks. This would make the system more available for users in a work environment or a personal home environment.

64. Claims 17 and 27 are rejected for similar reasons as stated above.

### ***Conclusion***

65. Applicant's arguments with respect to claims 1 – 30 have been considered but are moot in view of the new ground(s) of rejection.

66. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

67. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

68. a. Yotsukura U.S. Patent No. 6629122 discloses Information processing system and method for communications between application systems.

69. b. Montville et al. U.S. Patent No. 6356937 discloses Interoperable full-featured web-based and client-side e-mail system.

70. c. Eldridge et al. U.S. Patent No. 6397261 discloses Secure token-based document server.

71. d. McArdle et al. U.S. Patent No. 6442686 discloses System and methodology for messaging server-based management and enforcement of crypto policies.

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72. e. Kuzma et al. U.S. Patent No. 5781901 discloses Transmitting electronic mail attachment over a network using a e-mail page.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England  
Examiner  
Art Unit 2143

De 

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100